

A. CLAIMED COMBINATION PATENTABLE OVER CITED PRIOR ART

Claim 21 is the sole independent claim and stands rejected under 35 U.S.C. § 102 as being anticipated by Kobayashi et al.. This rejection is respectfully traversed for the following reasons.

None of the cited prior art, alone or in combination, disclose or suggest the combination of a solid organic conductive material and liquid electrolyte in the arrangement recited in claim 21. As previously noted, page 6, lines 2-10 of Applicants' specification describes one of the benefits/advantages of the combination of the solid organic conductive material and liquid electrolyte (which can provide a repair capability of the dielectric oxide film) as the ability to provide an electrolytic capacitor with extremely low inter-polar resistance, low leak current and high dielectric strength (high withstand/spark voltage).

Another benefit/advantage of the combination of a liquid electrolyte and solid organic conductive material as recited in claim 21 is the ability for the pressure elevation inside the capacitor to be suppressed and for defective soldering to be improved (*see, e.g.*, page 13, lines 11-19 of Applicants' specification). Some additional advantages and benefits are further discussed throughout Applicants' specification. For example, the Examiner is directed to pages 36-43 of Applicants' specification corresponding to the exemplary embodiments of the present invention in comparison to comparative examples for evidence of the benefits/advantages of the present invention over the prior art (note for example comparative example 2 on page 33 without a liquid electrolyte, which has an extremely large leak current relative to exemplary Embodiment 1 of the present invention with a liquid electrolyte; *see* Table 1 on page 36 of Applicants' specification).

In contrast, the entirely solid electrolytic capacitor of Kobayashi et al. does not have enough low leak current and high dielectric strength because it can not repair the oxide film effectively due to the entirely solid structure thereof (no liquid electrolyte). As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Kobayashi et al. does not anticipate claim 21, nor any claim dependent thereon. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 25-30 and 32 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 21 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on all the foregoing, it is submitted that claims 21-30 and 32 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 21-30 and 32 under 35 U.S.C. § 102/103 be withdrawn.

B. RESPONSE TO EXAMINER POSITION IN ADVISORY ACTION

Claim 21 recites in pertinent part, "disposing an electrolyte *between said positive electrode ... and said negative electrode*, wherein said electrolyte comprises a *liquid* electrolyte" (emphasis added). In the Advisory Action dated August 7, 2003, the Examiner alleges that "claim 21 reads on the case of two-layered solid electrolyte before the polymerization of the second layer." The Examiner therefore broadly interprets the second conductive polymer layer during an intermediate step before polymerization as the claimed liquid electrolyte.

However, during the intermediate step of Kobayashi et al. where the second conductive polymer is liquid, the negative electrode has not yet been formed. As expressly disclosed on col. 9, lines 32-40 and illustrated in Figures 4-9 of Kobayashi et al., the negative electrode 7,8 is formed only *after* the second conductive polymer has been *solidified* through polymerization. Accordingly, the alleged liquid electrolyte of Kobayashi et al. is NOT disposed between a positive and negative electrode as recited in claim 21. Instead, the alleged liquid electrolyte is disposed between the positive electrode *and air*, and thereafter the alleged liquid electrolyte is solidified so that a *solid* electrolyte is disposed between the positive electrode and the subsequently formed negative electrode. At no time during the process of Kobayashi et al. is an electrolyte comprising a liquid electrolyte disposed between a positive and negative electrode.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Kobayashi et al. does not anticipate claim 21, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 21 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is submitted that all pending claims are patentable over the cited prior art.

CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this

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paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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